



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,922	05/23/2001	Satoru Ueda	7217/64561	1620

530 7590 06/28/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

JUNG, DAVID YIUK

ART UNIT PAPER NUMBER

2134

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,922	Applicant(s) UEDA, SATORU	
	Examiner David Y. Jung	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

CLAIMS PRESENTED

Claims 14-22 are presented.

Response to Arguments

Applicant's arguments are given in the Remarks section at pages 5-7.

Applicant's arguments have been fully considered but they are not persuasive.

At pages 5-6, Applicant argued that neither Mullor nor the portion of Asai disclose "said software program and said user's access authorization data are stored on the portable storage medium" in which the user's access authorization data "includes information pertaining to a license involving said software program" as specifically recited in claim 14. This is, of course, irrelevant because this is an argument against the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

At pages 6-7, Applicant argued that the combination of the references was incorrect. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

Art Unit: 2134

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this situation, Applicant has also cited *In re Fitch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Applicant appears to wish (1) to interpret “the prior art” of this passage of *In re Fitch* to mean solely “the cited passages of the references that were relied in the rejection,” and (2) the Patent Office to cite a modification that uses bodily incorporation. That, of course, is not the law as interpreted by the Patent Office. In response to applicant's arguments regarding these matters, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Indeed, the Patent Office speculates that the law may even go further: the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 985). The official Patent Office view is that this case law (of *In re Keller*) has not been overruled by any subsequent case or statute.

In summary, Applicant is respectfully requested to provide arguments as to whether the combined teachings of the references would have suggested the modification to those of ordinary skill in the art – rather than to continue to argue that the claimed invention must be expressly suggested in any one or all of the references

CLAIM REJECTIONS

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullor and Asai (both cited in the previous Office Actions).

Regarding claim 14, Mullor teaches all but “portable storage medium.” See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use. Note that the very title of Mullor states its relation to license limitation. See also column 1, lines 53-58; column 2, lines 48-59; column 4, lines 19-24.

Asai teaches “portable storage medium” for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claims 15-17, these features are well known in the art for the purposes of distribution and security.

Regarding claim 18, Mullor teaches all but "storage medium" being "portable." See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use.

Asai teaches "storage medium" being "portable" for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claim 19, these features are well known in the art for the purposes of distribution and security.

Regarding claim 20, Mullor teaches all but "portable storage medium." See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use.

Asai teaches "portable storage medium" for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Art Unit: 2134

Regarding claims 21-22, these features are well known in the art for the purposes of distribution and security.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Art Unit: 2134

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Jacques Louis-Jacques whose telephone number is (571) 272-6962.

David Jung

A handwritten signature in black ink, appearing to be 'DJ' followed by a long, sweeping horizontal stroke that ends in a small upward flick.

Patent Examiner

6/26/06